

REMARKS

I. Amendments to the Specification

The title has been changed to more precisely reflect the invention of the elected group. Also, the first paragraph of the specification has been updated to reflect recent USPTO guidelines related to the formatting of priority claims in the specification.

In addition, the first paragraph of the specification has been amended to correct an unintentional typographical error that changed the last digit of the serial number of the immediate parent application of the present application. In particular, U.S. Application No. 09/666,984, filed September 21, 2000, was unintentionally designated U.S. Application No. 09/666,987.

Applicants note that the serial number of U.S. Application No. 09/666,984 was properly indicated on the Utility Patent Application Transmittal submitted with the instant application on March 30, 2001, contemporaneously with the preliminary amendment that introduced the incorrect serial number into the first paragraph of the specification. Furthermore, Applicants note that the instant correction of the last digit of the serial number for U.S. Application No. 09/666,984, does not change the earliest claimed priority date, July 30, 1997. Thus, this amendment does not change the scheduled date of publication of the present application. Accordingly, Applicants respectfully submit that a petition to accept an unintentionally delayed benefit claim need not accompany the current amendment for this correction to be entered.

II. Amendments to the Claims

Claims 1, 13, 17-20, and 22-34 are pending; claims 2-12, 14-16, and 21 have been canceled (without prejudice or disclaimer). Applicants reserve the right to pursue the subject matter encompassed by all canceled claims in one or more divisional or continuation applications. New claims 25-34 have been added to claim embodiments that Applicants regard as the invention. New claims 25-34 are completely supported by the specification as originally filed and thus no new matter has been added.

More particularly, support for new claims 25 and 30 can be found, for example, at page 153, line 36 to page 154, line 4 (minus N-terminal methionine). Support for new claims 26 and 31 can be found, for example, within Table 1 at page 127, row 5, indicated as "Gene No. 4" of the specification (full-length). Support for new claims 27 and 32 can

be found, for example, at page 150 line 32 to page 152, line 14 (fusion polypeptide). Support for new claims 28 and 33 can be found, for example, in Example 23 at page 208 (carrier). Support for new claims 29 and 34 can be found, for example, at page 152, line 15 to page 154, line 19 (express and recover polypeptide).

III. Provisional Election With Traverse

The Examiner has issued an election requirement separating the pending claims into 910 different groups. *See* Paper No. 4, pages 2-3. The Examiner contends that the inventions are distinct, each from the other.

To comply with the pending election requirement, Applicants herein provisionally elect, with traverse, the invention of group 95 represented by original claims 11-12 and 16 (now canceled), and new claims 25-34, drawn to polypeptides comprising amino acids 2-220 of SEQ ID NO:105, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that claims 2-12, 14-16, and 21 have been canceled without prejudice or disclaimer, and that new claims 25-34 are directed to subject matter falling within the ambit of Group 95 as cast by the Examiner.

With respect to the Examiner's division of the invention into 910 groups and the reasons stated therefor, Applicants respectfully disagree and traverse.

Even where patentably distinct inventions appear in a single application, restriction remains improper unless the examiner can show that the search and examination of these groups would entail a "serious burden". *See* M.P.E.P. § 803. In the present situation, although the Examiner has argued that Groups 1-91; 92-182; 183-273; 274-364; 365-455; 456-546; 547-637; 638-728; 729-819; and 820-910 (corresponding to section headings I-X in the Office Action, respectively) are separately classified or represent divergent subject matter, Applicants nonetheless submit that, with respect to a given sequence, a search of the claims of the groups directed to that sequence would also provide useful information for the claims of the other groups directed to that sequence. For example, in many if not most publications disclosing a protein, the authors also disclose nucleic acids encoding the protein, antibodies to the protein, and methods of making and using the same. Thus, since the searches for proteins, nucleic acids encoding such proteins, antibodies to such proteins, and methods of making and using the same commonly overlap, Applicants respectfully submit that the Examiner's assertion that the combined search and examination of such

compositions and methods using the same would entail a serious burden has been rebutted, even assuming *arguendo* that the searches were not coextensive.

Accordingly, in view of M.P.E.P. § 803, the restriction should be modified so that the claims of all the groups directed to a particular sequence (e.g., Groups 4, 95, 186, 277, 368, 459, 550, 641, 732, and 823) are searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn.

Further, although not acquiescing to the restriction requirement, Applicants nevertheless note that the Examiner has acknowledged that the claims of Groups 95 and the claims of groups 277, 459, 550, and 732 are related as between a product and processes for making or using the product. See Paper No. 4, pages 4-6. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), if an elected product claim is found allowable, “withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined.” M.P.E.P. § 821.04. Accordingly, Applicants respectfully request that if any of the claims of Group 95, i.e., new claims 25-34, are found allowable, then the process claims of Groups 277, 459, 550, and 732 be rejoined and examined for patentability.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

CONCLUSION

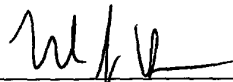
Applicants respectfully request that the amendments and remarks be entered and made of record in the file history of the instant application. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

If there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time

under 37 C.F.R. § 1.136, such an extension is requested and the fee should also be charged to our Deposit Account.

Dated: August 14, 2003

Respectfully submitted,

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